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In re Application of :
Bonutti :
Application No. 10/003,996 : DECISION ON PETITION
Filed: 15 November, 2001 :
Attorney Docket No. 780-A02-014-8 :

This is a decision on the petition filed on 18 August, 2010, pursuant to 37 C.F.R §1.182 requesting authorization to withdraw the terminal disclaimer filed 31 March, 2003.

**NOTE:**

Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of [a] terminal disclaimer have not been favorably considered. (*See*: MPEP §1490.)

As of this writing, there has been no response from the Patent Legal Research Center in this matter.

Moreover, the Examiner(s) in charge of this application expressly refused to concur in this request.

Any questions Petitioner may have in this regard **must** be directed to the Examiner

The petition pursuant to 37 C.F.R §1.182 is **DISMISSED**.

The guidance in the Commentary at MPEP §1490 provides in pertinent part:

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**VII.WITHDRAWING A RECORDED TERMINAL DISCLAIMER**

If timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent, or in a reexamination proceeding, before the reexamination certificate issues. After a patent or reexamination certificate issues, it is unlikely that a recorded terminal disclaimer will be nullified.

***A. Before Issuance Of Patent***

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. *>Because< the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application (other than by refiling it as a CPA).

Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR §1.182 requesting withdrawal of the recorded terminal disclaimer. Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered. The filing of a continuing application other than a CPA, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer. The filing of a Request for Continued Examination (RCE) of an application under 37 CFR §1.114 will not nullify the effect of a terminal disclaimer, *>because< a new application has not been filed, but rather prosecution has been continued in the existing application. (Emphasis supplied.)

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At the request of the Office of Petitions, the Examiner has reviewed Petitioner's representations and has noted (in pertinent part): " ... it appears that at least claim 41 has a obviousness-type double patenting issue with claim 10 of patent 5,403,317 and claim 60 has a double patenting issue with claims 1 of patents 5,403,317 and 5,694,951."

In addition and as previously noted, Petitioner's discussions made clear that Petitioner expressly determined for purposes of prosecution strategy to submit the terminal disclaimer notwithstanding Petitioner's own beliefs that the disclaimer was unnecessary.[1]

[1] *See*: Petition of 18 June, 2010, page 4, third paragraph.

Thus, Petitioner appears to have made choices deemed to provide to him a prosecution road to allowance, and the Office will not indiscriminately alter those choices.

Accordingly, the petition is **dismissed**.

This application is released to the Technology Center/AU 3733 for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[2]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's/Caller's action(s).

/ John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[2] The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing.The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation,or understanding in relation to which there is disagreement or doubt.